ably comparable as aforesaid shall be determined by a tribunal established under section 12 of the Industrial Training Act, 1964."

The plaintiff sought a declaration that he was entitled to have a "home to office" mileage allowance because it was another term and condition of his employment and that because it was knocked off, the terms and conditions of his employment were less favourable. Denning M.R. said at page 594:–

"Bridge J. held that he was not. Now there is an appeal to this court. It depends on the interpretation of article 66(3)(a) of the Order of 1966. The first point is whether the home to office mileage allowance was remuneration within the words "salary or remuneration" in sub-paragraph (i) of article 66(3)(a). I think it was probably not "remuneration". In that paragraph "remuneration" means remuneration for services rendered, but not an expense allowance. This home to office allowance was more in the nature of an expense allowance. It was re-payment of expenses actually incurred. No one would call it "remuneration" if he was paid his bus fares or his train fares or his actual out-of-pocket expenses. So I would hold that this home to office mileage allowance was not remuneration."

Orr L.J. and Roskill L.J. agreed with Denning M.R. Orr L.J. said:–

"Notwithstanding the decision of the Divisional Court in *S. & U. Stores Ltd.* v. *Lee* [1969] 1 W.L.R. 626, which was in a different context and involved in my judgment a car allowance of a different kind, I have not been persuaded that the mileage allowance here in question falls within the term "remuneration" as used in paragraph (3)(a) of article 66 of the Order of 1966."

Roskill L.J. said:–

"As regards the first ground on which the judge decided the case against the plaintiff, namely, that the home to office mileage allowance was part of his remuneration, I respectfully agree with Lord Denning M.R., when he said that this was 'a near thing'. On the whole, I agree with Lord Denning M.R. that it was not."

The object of the Act, which provides a scheme for compulsory contributions by employees during employment, with compulsory contributions by employers, was to ensure as far as possible that every employed person on reaching the age of retirement had accumulated sufficient savings to provide for himself or herself after retirement. In the context of the object I was of the opinion that the word "remuneration" in that definition means reward for services rendered by an employee to his employer but does not include any payment unconnected with services rendered.

On the facts of the present case the payments made by the company pursuant to claims under Clause 26(a)(ii) of the Collective Agreement were payments in the nature of reimbursements of transportation expenses incurred by the employees. In my opinion, whenever an employee of the company is required to attend for work in circumstances which entitle him to transportation under Clause 26(a) but the company is unable to supply its own transport, the employee has the immediate right under Clause 26(b) to be reimbursed by the company for the transportation expense incurred by him. That being so, the fact that for administrative convenience the employee was not reimbursed immediately but was reimbursed at the same time as his salary did not alter the nature of the payment from reimbursement to reward for services rendered. For these reasons I allowed the appellant company's appeal.

Appeal allowed.

Solicitors: *Chelliah & Co.*

JORDACHE ENTERPRISES INC. v. MILLENNIUM PTE. LTD.

[O.C.J. (Thean J.) January 10, 1985]
[Singapore – Suit No. 5430 of 1982]

Trade mark – Close resemblance causing deception or confusion – Infringement of trade mark – Passing off – Injunction – Damages.

Passing off – Whether requirements satisfied.

The plaintiffs registered their trade mark "Jordache" on October 3, 1979 in Singapore in respect of men's and women's jeans. On May 10, 1982 they appointed a company as the sole agent for distribution and sale of jeans bearing the trade mark "Jordache" in Singapore. When the plaintiffs were making preparation to launch their jeans, the defendant, a Singapore company, were also preparing to launch on the market their jeans bearing the unregistered trade mark "Jordane". Upon discovery that the defendants had used the trade mark "Jordane", the plaintiffs immediately took out the present action against the defendants on December 14, 1982. Two issues, infringement and passing off, fell for decision.

Held: (1) looking at and listening to the two names "Jordache" and "Jordane" the Court ineluctably arrived at a conclusion that one so closely resembled the other as to be likely to deceive or cause confusion in the course of trade. The defendants by the use of their trade mark "Jordane" have infringed the plaintiff's trade mark "Jordache";

(2) the plaintiffs have failed to establish their claim for passing off;

(3) an injunction should be granted restraining the defendants and they must deliver to the plaintiffs for destruction all labels, marks, advertisements, documents and other materials bearing the trade mark "Jordane";

(4) there would be an inquiry as to damages, if any, suffered by the plaintiffs and occasioned by such infringement of trade mark;

(5) the plaintiffs were allowed two thirds of the costs of the action.

Cases referred to:

(1) *Cadbury Schweppes Pty. Ltd.* v. *Pub Squash Pty. Ltd.* [1981] 1 W.L.R. 193, 204.

(2) *Fletcher Challenge Ltd.* v. *Fletcher Challenge Pty. Ltd.* [1982] F.S.R. 1.

(3) *Stannard* v. *Reay* [1967] R.P.C. 589.

CIVIL SUIT.

Harry Elias for the plaintiffs.
Sia Moon Joon for the defendants.

Cur. Adv. Vult.

Thean J.: The Plaintiffs, a corporation established in the State of New York, United States of America, are registered proprietors of a trade mark, "Jordache", in Class 25 in respect of, *inter alia*, men's and women's jeans. The trade mark was registered in Singapore on October 3, 1979 and at that time jeans bearing that trade mark had already become a well known brand in the United States of America. It was, however, not used by the Plaintiffs in Singapore until November 1982. On May 10, 1982, the Plaintiffs entered into an agreement with F.J. Benjamin & Sons (Pte.) Ltd. ("FJB") appointing the latter as the sole agent for distribution and sale of jeans bearing the trade mark, "Jordache", in Singapore. Arrangements were then made to launch their products on the market. FJB showed the said trade mark (and presumably the Plaintiffs' jeans) to dealers in Singapore in September 1982 and obtained "free bookings" from departmental stores and jeaneries for the Plaintiffs' jeans. The term "free booking" is understood in the jean trade to mean a commitment by dealers to purchase jeans for sales in consideration of the manufacturer agreeing to support such sales by advertisements. The first advertisement of Jordache jeans appeared in the local newspaper, the *Straits Times*, on August 17, 1982. That, however, was only an advertisement for appointments of a product manager and sales representative in FJB and the actual advertisement of Jordache jeans appeared in the issue of the *Straits Times* on November 18, 1982. FJB started delivery of Jordache jeans to their dealers in November 1982; the first sale of jeans bearing the "Jordache" trade mark by FJB in Singapore was made on November 18, 1982.

Rather curiously, at or about the time when the Plaintiffs were finalising their agreement with FJB and making preparation for a launch of their jeans, the Defendants, a company incorporated in Singapore, were also preparing to launch on the market, their jeans bearing the trade mark, "Jordane". Originally, they planned to launch their jeans in time for the Hari Raya which was on July 22, 1982. Having failed to do so they made preparation for a launch just before Christmas or around that time. They arranged for mobiles bearing the trade mark, "Jordane", to be prepared and these were placed in certain shops in August or September 1982 and the light boxes exhibiting such trade mark for installation in shops selling Jordane jeans were ready in October or November, 1982. The first advertisement of Jordane jeans appeared over the television on November 14, 1982, though at that time, such jeans were not available in the market; the jeans came on to the market only on November 18, 1982.

Upon discovering that the Defendants had used the trade mark, "Jordane", in respect of jeans, the Plaintiffs immediately took out a writ against the Defendants on December 14, 1982. The Plaintiffs claim that the Defendants' trade mark so nearly resembles the Plaintiffs' trade mark as to be likely to deceive or cause confusion in the course of trade in relation to jeans and further, or in the alternative, that the trade mark, "Jordane", is nearly identical to and closely resembles the distinctive trade mark, "Jordache", and the use of it by the Defendants is likely to deceive and is intended and calculated to deceive the trade and the public into believing that the Defendants' jeans are those of the Plaintiffs and by using their trade mark, "Jordane", the Defendants are passing off the Defendants' jeans as and for the Plaintiffs' jeans or as having some connections with the Plaintiffs' jeans. Both these claims are resisted by the Defendants. There are therefore two issues before me, namely:

(a) First, whether the Defendants by their use of their trade mark, "Jordane", have infringed the Plaintiffs' registered trade mark, "Jordache".

(b) Secondly, whether the Defendants' trade mark is so identical to and so closely resembles the Plaintiffs' trade mark that by the use thereof the Defendants have passed off and enabled others to pass off their jeans as and for the jeans of the Plaintiffs or as having some connections with the Plaintiffs' jeans.

DW 1, the managing director of the Defendants, said that he conceived the trade mark, "Jordane", after one or two trips to the Middle East and particularly to the country Jordan in 1981. He was impressed by that country and the name. He therefore decided to adopt the name Jordan but was advised that the name of a country could not be registered as a trade mark. Hence he gave it a slight variation by adding an alphabet "e" at the end thereof. At that time he was also advised that there might be possible objection from owners of the trade marks "Charles Jourdan" and "Pierre Jourdan". He was further advised to try to have the trade mark "Jordane" with a logo registered in London, and as it would take a long time to obtain an answer on the results of such registration, he decided to go ahead with his plan to use the trade mark, "Jordane", for the Defendants' jeans. He said that at that time he was not aware of the Plaintiffs' trade mark, "Jordache", though it was already registered with the Registry of Trade Marks in Singapore.

I find it completely puzzling that the Defendants were advised to register, and did seek to register, the trade mark, "Jordane", in London, when they wished to use the trade mark here. Even more puzzling it is to find that at that time no attempt was made to register the trade mark in Singapore or carry out a search to ascertain whether a similar mark in respect of jeans was registered with the Singapore Registry of Trade Marks. No explanation for such course of action was given by DW 1. Nor do I find convincing his evidence that the trade mark, "Jordane", was derived from the name of the country Jordan. That the name Jordan is a nice name is not disputed and it may well be that he was impressed by Jordan. But I do not believe that he derived his inspiration for the trade mark from the name of that country or his visit to that country. I also do not accept his evidence that at the time when he sought legal advice on the use of the name, Jordan or Jordane as a trade mark, he did not know of the trade mark, "Jordache". First, he was in the jean business for about 13 years at that time and must have either read or heard of Jordache jeans, then a well known brand in the United States of America. Secondly, very likely a search must have been made and he must have been advised that there was a trade mark, "Jordache", already registered with the Registry of Trade Marks, Singapore. It is inconceivable that his solicitor had not done this at that time. It seems to me likely that he derived his inspiration for the name, "Jordane", from such names as "Charles Jourdan", "Pierre Jourdan" or "Jordache" or an amalgam of these names. He might not have known and, in all probability, did not know that the Plaintiffs, through their agents, FJB were making preparation for a launch of their product in Singapore. However, whether or not he knew of this fact does not affect my decision on the first issue.

There is no doubt that if the two words "Jordache" and "Jordane" are placed side by side and considered each as a whole, there is a great deal of similarity between the two. As for the pronunciation, "Jordache" is pronounced as "Jor-dash" and the "Jordane" is pronounced as "Jor-dane (the second syllable as in "cane"). In each case the emphasis is on the second syllable. There may be a slight variation, however, in that in certain quarters the word in each case or in either of them may be pronounced with the emphasis on the first syllable or with a drawl on the first syllable. It may be also that when the Plaintiffs' jeans first appeared on the local market their trade mark, "Jordache", was pronounced as "Jor-daki", "Jor-darji" or "Jordak". Assuming that that was the position, the dealers and consumers of Jordache jeans would soon come to know from advertisements appearing on television or in cinema or radio that the correct pronunciation of "Jordache" is "Jor-dash". Looking at and listening to the two names "Jordache" and "Jordane", I ineluctably arrive at a conclusion that one so closely resembles the other as to be likely to deceive or cause confusion in the course of trade. I therefore find that the Defendants by the use of their trade mark, "Jordane", have infringed the Plaintiffs' trade mark, "Jordache".

On the second issue, the Plaintiffs in my judgment have failed to establish their claim for passing off. In an action for passing off the first matter the Plaintiffs must establish is that the get-up of their goods has become so distinctive of their goods that it is associated and identified with them. The Plaintiffs sought to show that the typeface of the word, "Jordache" and the burgundy label on which the word "Jordache" appears in white are distinctive of their jeans. I do not agree. These two features are common for jeans and have been adopted by a number of other manufacturers of jeans.

The other matter which the Plaintiffs must establish if they are to succeed in their claim for passing off is that at the relevant date their jeans or their business had acquired a certain goodwill or reputation, and the relevant date is the date of commencement of the conduct of the Defendants complained of, *i.e.* November 1982, when the De-

fendants launched their jeans on the market: see *Cadbury Schweppes Pty. Ltd.* v. *Pub Squash Pty. Ltd.*[1] At the time of the launch of the Defendants' jeans on the market the Plaintiffs had just launched their jeans under the brand name "Jordache", and Jordache jeans were not a well known brand in the jean market in Singapore. On this point I reject entirely an exaggerated claim made by PW 2, the managing director of FJB, that in September 1979 "Jordache" was already a well known name in the local market and that by December 31, 1981, the name "Jordache" could have been known to a wider spectrum of dealers and consumers. Presumably he made this statement on the basis that "Jordache" jeans created a large impact in United States of America and that people travelled and must have bought such jeans and brought them back to Singapore. This is purely a conjecture. No evidence however has been adduced in support of such an exaggerated claim. Reliance obviously was also placed on an unsolicited article appearing in the issue of *Time* magazine of September 10, 1979 of the success of Jordache jeans in the United States of America, and an advertisement appearing in the *Silver Kris* magazine in September 1982, which is an in-flight magazine of Singapore Airlines Limited. I have grave doubts that the article in the *Time* magazine had really come to the notice of a large sector of jean consumers, and at any rate, there is no evidence to show that it had. As for the *Silver Kris* magazine it is not in dispute that it has a very limited circulation: it is available only to passengers on board the aircrafts of Singapore Airlines. In so far as the goodwill or reputation of the business of the Plaintiffs is concerned, no one has even ventured to suggest, and there is not a shred of evidence to the effect, that their business had acquired a certain goodwill or reputation in Singapore.

Mr. Elias on behalf of the Plaintiffs urged on me that reputation of a product could be acquired very quickly and relied on *Fletcher Challenge Ltd* v. *Fletcher Challenge Pty Ltd*[2] and *Stannard* v. *Reay*[3]. The facts of these two cases are entirely different from those in the instant case and they are of no assistance to me. In the first case, the plaintiff, a public company, was incorporated in New Zealand as a holding company for three substantial companies pursuant to a scheme of amalgamation. Prior to its incorporation, the scheme was submitted to shareholders of the three companies for approval and wide publicity was given in New Zealand and Australia to the proposal and to the fact that the proposed holding company would be called "Fletcher Challenge Ltd." At about that time two individuals registered a company, the defendant, in New South Wales under the name, Fletcher Challenge Pty Ltd, with the result that when the plaintiff applied for a reservation of its name, that application was refused, as such name was likely to be confused with the name of the defendant. Thereupon, the plaintiff initiated proceedings against the defendant seeking an injunction to restrain the defendant from carrying on business under the name "Fletcher Challenge". Powell J. held that as the cause of action is one of passing off the plaintiff had to establish, *inter alia*, its business had acquired a certain goodwill or reputation, and that in the circumstances the plaintiff had the reputation: it had the combined goodwill of the three constituent companies or, alternatively, the announcement of the proposed amalgamation and the proposed holding company created a new reputation for the plaintiff. In the second case, the plaintiffs started the business of selling fish and chips on a mobile van in the Isle of Wight under a trade name, "Mr. Chippy'. Soon after such business was commenced – about three weeks later – the defendants embarked on similar business using a similar mobile van also under the same trade name, "Mr. Chippy". The plaintiffs thereupon brought proceedings against the defendants claiming for an injunction restraining the defendants from passing off their fish and chips as the plaintiffs' by the use of the trade name, "Mr Chippy". In granting an interlocutory injunction Buckley J. (as he then was) held that though only a short period had lapsed since the plaintiffs started their business, it had in the circumstances prevailing acquired some reputation. He said, at p.592:

> "It would seem from the evidence that probably the plaintiffs were the only people in the Isle of Wight carrying on this sort of trade in this sort of way at the time when they began their business in October 1966. There is no suggestion that there were any other mobile fish and chip vans then operating in the Isle of Wight, and, although a period of three, four or five weeks may be a short time in which to build up a goodwill associated with a particular trade name, it does not seem to me to be by any means impossible to suppose that amongst those members of the public who enjoy fish and chips and who find it convenient to be able to buy them ready cooked and supplied at convenient places where they can go and collect them a new business of this kind might not attract to itself considerable notice and trade within quite a short time, and I think that there is to some extent supported by the evidence of the first plaintiff to the effect that in the first complete week of trading after the plaintiffs had put their fish and chip van on to the road, that is to say, the week ending October 26, 1966, the takings of the fish and chip van amounted to £129 7s. 6d., and in the next week to £138 16s. 10d., and in the third week to £133 12s. 3½d., amounts which seem to me to be substantial sums to be taken by one van in a business of this kind."

Nothing of the kind as said by Buckley J. had occurred in the case of Jordache jeans in Singapore. There is no evidence to show that immediately after the launch the Jordache jeans made a great impact in the jean market and immediately acquired a reputation.

I now make an order as follows: first, an injunction restraining the Defendants by themselves, their officers, servants or agents or any of them or otherwise from infringing or causing or enabling or assisting any other persons to infringe the Plaintiffs' trade mark, "Jordache"; secondly, delivery to the Plaintiffs for destruction of all labels, marks, advertisements, documents and other materials bearing the trade mark, "Jordane", and thirdly, an enquiry as to damage, if any, suffered by the Plaintiffs and occasioned by such infringement of trade mark. On the question of costs, if the Plaintiffs had proceeded with a claim only for infringement of their trade mark, as they should have done so, the trial would not have been so prolonged. As it turned out, this trial lasted for seven full days and a great deal of time was devoted to the question of passing off. Since they failed in their claim for passing off, the Plaintiffs should not be allowed the full costs of this action. Accordingly, I allow to the Plaintiffs only two thirds of the costs of this action.

Order accordingly

Solicitors: *Drew & Napier; Chor Pee & Co.*

MALAYSIAN REPORTS

CITY INVESTMENT SDN. BHD. v. KOPERASI SERBAGUNA CUEPACS TANGGUNGAN BHD.

[F.C. (Lee Hun Hoe C.J. (Borneo), Mohamed Azmi & Abdoolcader F.JJ.) August 23, 24 & 29 & December 17, 1984]

[Kuala Lumpur – Federal Court Civil Appeal No. 30 of 1984]

Contract – Housing development contract – Sale of immovable property – Breach of Contract – Specific performance – Damages – Remoteness – Specific performance of part of contract – Housing Developers Rules, 1970, r.12 – Specific Relief Act, 1950, ss. 3, 11, 14 & 18.

Land Law – Sale of immovable property – Breach of contract – Specific performance.

Housing Developers – Breach of contract – Specific performance – Housing Developers (Control and Licensing) Act, 1966 – Housing Developers Rules, 1970, r. 12 – Specific Relief Act, 1950, ss. 3, 11, 14 & 18.

In this case the appellants were the registered owners of a piece of land which they decided to develop into housing lots. They entered into two separate agreements with the respondents for the sale of a portion of the land to be developed. In the first agreement the appellants agreed to sell and the respondents agreed to buy 60 terrace houses and at the request of the respondents the appellants also agreed to appoint themselves or a third party as licensed developer with whom the respondents could execute a building contract for the construction of the terrace houses. The respondents have paid the sum of $720,000 to the appellants consisting of $300,000 as land price and $420,000 as development price. In the second agreement the appellants agreed to sell and the respondents agreed to buy 25 subdivided lots, 15 semi-detached lots and 11 bungalow lots. The respondents have paid $426,300/- for these lots comprising of $172,000/- as land price and $254,300 as development price. Out of the 85 lots sold, the appellants have transferred to the respondents only one terrace lot under the first agreement and one semi-detached lot under the second agreement. Ten of the bungalow lots under the second agreement were found to be commercially useless as it would cost about $13 million to level the land. The learned trial judge held that the first agreement was a sale of land with houses and therefore caught by the Housing Developers legislation. He found that the appellants were in breach of both the written agreements for their failure to transfer the various lots to the respondents. In respect of the first agreement he ordered specific performance for the transfer of the remaining 59 terrace-lots to the respondents and he also awarded compensation for consequential loss which included, *inter alia,* damages for additional costs in constructing the 60 terraced houses and $187,200/- as indemnity under the Housing Developers Rules, 1970. In regard to the Second agreement he ordered specific performances for the transfer of the remaining 13 semi-detached lots and 1 bungalow lot. For the 10 useless bungalow lots the appellants were ordered to refund the contract price of $203,000/- with interest. In addition to